

REMARKS

Claims 1-8, 17-21 and 23-25 are pending in this application. By this Amendment, claim 1 is amended to address the rejections under 35 U.S.C. §112, first and second paragraphs set forth in the May 20, 2003 Office Action. No new matter is added by this Amendment, support for the amendment to claim 1 being found in the original specification at, for example, page 1, lines 9-10, page 2, lines 20-21 and page 4, line 32 to page 5, line 17, explaining that both 1,4-butane diol and araliphatic diol are present in the composition, 1,4-butane diol being required as chain extender in the polyurethane, and explaining that these diols together form 5 to 20 wt.% of the total weight of the composition, with 0.5 to 10 wt.% being the araliphatic diol.

The courtesies extended to Applicants' representative by Examiner Sergeant at the interview held August 18, 2003, are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below and constitute Applicants' record of the interview.

I. Rejection Under 35 U.S.C. §112, Second Paragraph

Claims 1-8, 17-21 and 23-25 were rejected under 35 U.S.C. §112, second paragraph as allegedly being indefinite. This rejection is respectfully traversed.

In the Office Action, it was first alleged that it was not clear from claim 1 whether 1,4-butane diol was a required component or merely an optional component of the composition. Applicants respectfully submit that in view of the description of the weight percentages for 1,4-butane diol and araliphatic diol in claim 1, the claim was quite clear in scope. That is, one of ordinary skill in the art would readily be able to determine whether or not a given composition was within or outside the scope of claim 1 based upon the components and weight percentages thereof present in the composition. As such, claim 1 was clear, and the allegation in the Office Action alleging a lack of clarity was without merit.

However, in an effort to expedite prosecution of this application, Applicants have amended claim 1 to further clarify that both 1,4-butane diol and the araliphatic diol must be present in the composition. Further, claim 1 requires a chain extender, the specification confirming that the 1,4-butane diol forms a chain extender. This further confirms that the 1,4-butane diol must be present in the composition in order to participate in forming the required chain extender of the polyurethane.

The Office Action then further alleged that if 1,4-butane diol was a required component of the composition, then it was unclear how to determine the relative amounts of 1,4-butane diol and araliphatic diol. Applicants disagree. Claim 1 clearly recites that 5 to 20 wt.% of the total weight of the composition is made up of the combined amount of 1,4-butane diol and araliphatic diol, with 0.5 to 10 wt.% of the total weight of the composition being made up of the araliphatic diol. Thus, claim 1 is clear in defining that 0.5 to 10 wt.% of the total weight of the composition is the araliphatic diol, and that some additional amount of 1,4-butane diol is present, the additional amount of 1,4-butane diol being an amount greater than 0 so long as the combined amount of 1,4-butane diol and the araliphatic diol comprises 5 to 20 wt.% of the total weight of the composition. Other than this clear relationship set forth in claim 1, the relative amounts of 1,4-butane diol and araliphatic diol are not limited and need not be specified to clarify the claim. Amended claim 1 is clear in reciting that both the 1,4-butane diol and the araliphatic diol must be present in the composition in the amounts as explained immediately above. The allegation that the claim is unclear for not reciting the relative amounts of 1,4-butane diol and araliphatic diol is without merit.

Finally, the Office Action alleged that claim 1 did not recite the basis for the amounts of 1,4-butane diol and araliphatic diol. By this Amendment, claim 1 has been amended to indicate that the amounts of 1,4-butane diol and araliphatic diol are based upon the total weight of the composition.

For all the foregoing reasons, Applicants respectfully submit that claim 1 is clear and definite in accordance with the requirements of 35 U.S.C. §112, second paragraph.

Reconsideration and withdrawal of this rejection are respectfully requested.

II. Rejection Under 35 U.S.C. §112, First Paragraph

Claims 1-8, 17-21 and 23-25 were rejected under 35 U.S.C. §112, first paragraph as allegedly containing subject matter not supported by an adequate written description. This rejection is respectfully traversed.

The Office Action alleged that the written description failed to adequately describe whether 1,4-butane diol is a required or optional component, and further alleged that the written description failed to describe the criteria for determining the relative amounts of 1,4-butane diol and araliphatic diol to be used. Applicants respectfully disagree.

First, it is quite clear from the written description that 1,4-butane diol is a required component of the composition. Specifically, the specification makes quite clear that the polyurethane must include a chain extender (see page 1, lines 9-10) and further describes that the 1,4-butane diol participates in formation of the chain extender. See, for example, page 4, line 32 to page 5, line 4. As the chain extender is described to be a required component of the polyurethane, and it is described that 1,4-butane diol in the composition is a source of the chain extender, it is quite clear from the specification that 1,4-butane diol is a required component of the composition. Further, it is evident from reviewing the examples on pages 10-12 of the specification, including the examples summarized in Table 2, that 1,4-butane diol is present in the composition.

Second, Applicants submit that it is not necessary to set forth any criteria for determining the relative amounts of 1,4-butane diol to araliphatic diol since the relative amounts of these components to each other is without limitation. As was discussed above, the only limitation regarding the amounts of 1,4-butane diol and araliphatic diol to each other is the weight percentage limitations set forth in claim 1. That is, the only limitation is that 0.5

to 10 wt.% of the total weight of the composition must comprise araliphatic diol, and any amount of 1,4-butane diol may then be present with respect thereto so long as the combined total amount of 1,4-butane diol and araliphatic diol falls within 5 to 20 wt.% of the total weight of the composition. This relationship is clearly set forth in the specification, and thus adequately describes these components of the composition.


For all the foregoing reasons, Applicants respectfully submit that the written description is adequate to describe the claimed invention to one of ordinary skill in the art. Reconsideration and withdrawal of this rejection are thus respectfully requested.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-8, 17-21 and 23-25 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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